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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,654	12/31/2001	Gregory F. Jacobs	53750US002	9214

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EXAMINER

HARTMANN, GARY S

ART UNIT	PAPER NUMBER
3671	

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/039,654	<b>Applicant(s)</b> JACOBS ET AL.
	<b>Examiner</b> Gary Hartmann	<b>Art Unit</b> 3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 31 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ .	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 9, 10, and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al. (U.S. Patent 5,853,846). Clark et al. discloses forming an array of magnetic pavement elements (6) interconnected by a carrier web (4, 12, 21). The connection between elements (Figure 5, for example) is frangible.

The configurations of webs (4, 12, 21) meet the recitations of claims 2-4.

The magnetic particles (6) are distributed in a binder (4).

There is an alternating polarity.

The adhesive (8) is optionally pressure sensitive, and there is a liner (10) covering the adhesive.

Regarding claim 9, webs 4 and 12 are polymeric materials and web 21 is a non-woven web.

The elements are adhered to a pavement surface.

The elements are formed in a predetermined pattern.

The web meets the recitation of extensible carrier web.

3. Claims 1-5 and 6-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Dahlin et al. (U.S. Patent 6,468,678). Dahlin et al. discloses forming an array of magnetic pavement elements (6) interconnected by a carrier web (4, 12, 21). The connection between elements (Figures 6 and 7, for example) is frangible.

The configurations of webs (4, 12, 21) meet the recitations of claims 2-4.

The magnetic particles (6) are distributed in a binder (4).

The adhesive (8) is optionally pressure sensitive, and there is a liner (10) covering the adhesive.

The web is severed.

Regarding claim 9, webs 4 and 12 are polymeric materials and web 21 is a non-woven web.

The elements are adhered to a pavement surface.

The elements are formed in a predetermined pattern.

The web meets the recitation of extensible carrier web.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. as applied above, and further in view of Ryan et al. (U.S. Patent 4,123,140). Clark et al. is silent with respect to severing the apparatus. Ryan et al. teaches cutting a paving element formed on a carrier web. In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have cut the apparatus of Clark et al. in order to suit a particular application.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlin et al. as applied above, and further in view of Clark et al., as applied above. Dahlin et al. is silent regarding polarity. Clark et al. teaches the alternating polarity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the alternating polarity of Clark et al. with the apparatus of Dahlin et al. in order to convey information as desired.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references teach pavement markings.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 703-305-4549. The examiner can normally be reached on Monday through Friday, 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 703-308-3870. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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May 5, 2003



**Gary Hartmann  
Primary Examiner  
Art Unit 3671**